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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/783,637

02/14/2001

David L. Brock

5138CON

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04/30/2004

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 04/30/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,637

Applicant(s)

BROCK ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-60 and 101-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-60 and 101-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-60, 101-104 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno et al. (5,876,325).

With respect to claims 26, 101, Mizuno et al. discloses a surgical instrument system for use in surgical procedures, the surgical instrument system comprising a guide assembly including an elongated portion having a longitudinal axis of rotation, a receiving passage and a distal end that is positioned a radial distance away from the longitudinal axis; as best seen in FIG.59; a surgical tip assembly (581) disposed through, and at least partially supported by the receiving passage of the guide assembly; as best seen in FIG.59; a drive unit, (505), coupled to at least the guide assembly for rotating the guide assembly and, by virtue of the distal end being disposed a radial distance away from the longitudinal axis, thereby causing the distal end of the surgical tip assembly to orbit the longitudinal axis; as best seen in FIGS.59-62.

With respect to claims 27-31, 102, 104, Mizuno et al. disclose all the limitations; as best seen in FIGS. 1-70, and as set forth in column 43, lines 1-67, column 44, lines 1-26.

With respect to claim 32, Mizuno et al. discloses a surgical instrument system for use in surgical procedures, the surgical instrument system comprising a guide assembly

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in a surgical environment, the guide assembly including a proximal end and a distal end, and including a passage along a longitudinal length of the guide assembly, the guide assembly being adapted for insertion into a patient and being adapted for rotation about a longitudinal axis of the guide assembly when inserted into the patient; as best seen in FIG.59; an instrument member having an end effector (581) that is used in surgical procedures, and is received by the proximal end of the guide assembly, passed through the passage, and to the distal end of the guide assembly within the patient and; as best seen in FIG.59; a drive unit, (505), coupled to the instrument member for manipulating the end effector (581) within the patient; as best seen in FIGS.1-70.

With respect to claims 33-41, Mizuno et al discloses all the limitations as set forth in columns 43, lines 1-67, column 44, lines 1-26; and, as best seen in FIGS.1-70.

With respect to claim 42, Mizuno et al discloses a surgical instrument apparatus comprising a surgical instrument, a distal end that carries a surgical procedure member and that is adapted to be inserted into a patient during surgery, a proximal end that is adapted to remain outside of the patient during surgery; as best seen in Fig.59; and; a plurality of link members disposed intermediate the proximal and the distal ends coupled to one another via at least one joint that is interposed between adjacent link members, at least some of the link members being located at the distal end of the instrument, the instrument providing at least five degrees of freedom of movement of the distal end of the instrument inside of the patient; as set forth in column 35, lines 25-42, and as best seen in FIG.8; a tubular adaptor having means for receiving and supporting the surgical instrument with the distal end of the surgical instrument

extending beyond a distal end of the tubular adaptor; as best seen in FIG.59; and drive means, as best seen in FIG.57 for effecting movement of the plurality of link members about at least one joint and for controlling rotation of the adaptor while supporting the instrument.

With respect to claim 43, Mizuno et al discloses a surgical instrument for use in procedures that are performed at an operative site internal of a patient, the surgical instrument comprising a guide member including a proximal end and a distal end that is adapted to be inserted into a patient, the guide member being adapted to rotate with respect to a longitudinal axis thereof; as best seen in FIG.57, 59; an end effector (581) for use during surgical procedures, the end effector being separable from and insertable into a patient through the guide member; and actuation means, as best seen in FIG.57,59 for effecting movement of the end effector by rotation of the guide member.

With respect to claims 44-51, Mizuno et al disclose all the limitations, as set forth in column 35, lines 25-42; and, as best seen in FIGS.1-70.

With respect to claim 52, Mizuno et al discloses all the limitations: a guide assembly, a support, a surgical insert, a drive unit controlled from a user input device, a user interface, a plurality of motors; as best seen in FIGS 1-70, and as set forth in columns 2-49, lines 1-67.

With respect to claims 53-56, Mizuno et al. discloses all the limitations, as set forth in column 2-49, lines 1-67, and as best seen in FIGS.1-70.

With respect to claims 57-60, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

Response to Amendment

Applicant's arguments, see remark, pages 10-13, filed 2/12/04, with respect to the rejection(s) of claim(s) 26-104 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mizuno et al.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
April 21, 2004


PEDRO PHILOGÈNE
PRIMARY EXAMINER